

Application No. 10/765,797

Reply to Office Action

REMARKS

Reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

Status of the Application

Claims 1 and 4-12, 14, 15, 17-19, 21-25, 27, 28, 30, 31, 33, 34 and 36 are currently pending, with claims 2, 3, 13, 16, 20, 26, 29, 32 and 35 being canceled, without prejudice, and new claim 36 (in place of canceled claim 2) being added.

Claims 1-29 were examined on the merits, while claims 30-35 were not in view of an objection entered against those claims in the Office Action (described below).

Applicants note that claims 4, 11, 14, 17, 21, 24 and 27 are not subject to a substantive rejection.

Summary of the Office Action

The Office Action opens by objecting to the disclosure due to a typographic error on page 1.

The Office Action continues by objecting to claims 30-35 as being in improper form because each dependent claim improperly attempts to incorporate a portion of another dependent claim by reference.

The specification, at page 4, lines 13 and 14, is objected to as failing to provide a proper antecedent basis for the claims.

Claims 1-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, because dashes are included in claim 1, the claim language is said to not clearly describe whether it refers to three or two polymers.

Claims 24 and 27 are also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action states that each claim, dependent on claim 4, contains language which renders the claim unclear as to whether the precursor of claims 24 and 27 is entirely encompassed within the precursor of claim 4.

Claim 25 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action states that whether the precursor of claim 25 is entirely encompassed with the precursor of claims 2 is unclear due to the broader language in claim 25 describing the infrared light absorbing dye.

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Claims 24 and 27 are also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action states that each claim, dependent on claim 3, is unclear because the counter ion in claim 26 is optional and not limited to being comprised of a perfluoroalkyl group containing 6 or more fluorine atoms. Thus, whether the precursor of claims 26 and 29 is entirely within the precursor set forth in claim 3 is unclear.

Turning to the substantive aspects of the Office Action, claims 1-3, 5-10, 12, 13, 15, 16, 18-20, 22, 23, 25, 26, 28 and 29 are rejected as obvious over WO 99/21725 ("McCullough") in view of EP 1 162 078 A2 ("Nakamura").

Claims 1-3, 5-10, 12, 13, 15, 16, 18-20, 22, 23, 25, 26, 28 and 29 are rejected as obvious over EP 1 256 444 A1 ("Vermeersch '444") in view of Nakamura.

Claims 1-3, 5-10, 12, 13, 15, 16, 18-20, 22, 23, 25, 26, 28 and 29 are rejected as obvious over EP 1 249 341 ("Vermeersch '341") in view of Nakamura.

Remarks

Objection to the Disclosure

Applicants have amended the first paragraph of the specification to correct the typographic error therein. Withdrawal of the objection is respectfully requested.

Objection to Claims 30-35

Applicants have amended claims 30-35 to remove the reference to claim 8 therein, substituting therein text taken from claim 8. Applicants respectfully request examination of these claims (as amended) on the merits.

Objection to the Specification for Lack of Antecedent Basis

Applicants have removed a reference to claim 1 appearing on page 4 of the specification as filed. As the claims are fully supported by the specification, withdrawal of the objection is respectfully requested.

Rejection of Claims 1-29 Under 35 U.S.C. § 112, Second Paragraph

Applicants have addressed this rejection by introducing the language set forth at page 5 into claim 1. In view of this amendment, Applicants respectfully request withdrawal of the rejection.

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Rejection of Claims 24 and 27 Under 35 U.S.C. § 112, Second Paragraph

Applicants have amended claim 24 as suggested in the Office Action, and in doing so have also addressed the rejection of claim 27. Withdrawal of the rejection is, therefore, respectfully requested.

Rejection of Claim 25 Under 35 U.S.C. § 112, Second Paragraph

Applicants have amended claim 25 as suggested in the Office Action. Withdrawal of the rejection is, therefore, respectfully requested.

Rejection of Claims 26 and 29 Under 35 U.S.C. § 112, Second Paragraph

Applicants have canceled claims 26 and 29, rendering this rejection moot. Withdrawal of the rejection is respectfully requested.

Obviousness Rejections

McCullough discloses and teaches a printing plate comprising water-repellant siloxanes. Nakamura teaches the use of an infrared absorbing dye with a covalent bonded surface orientation group, such as a perfluoralkyl group.

In marked contrast, the inventive lithographic printing plate precursors include, *inter alia*, infrared dyes comprising at least one perfluoroalkyl group, wherein the infrared light absorbing dye carries a charge and at least one perfluoroalkyl group is included in a counter ion and contains at least 6 fluorine atoms (claim 1 and those claims dependent thereon) or the aforesaid infrared light absorbing dyes which further comprises at least one covalently bonded perfluoroalkyl group (claim 36 and those claims dependent thereon). Dyes as described in the claims are not disclosed or taught by Nakamura—There is no suggestion therein that would motivate one skilled in the art to modify the Nakamura dyes in a manner that would provide the dyes as described in the claims. Accordingly, even assuming that the references are properly combinable, their combination would not yield the invention as claimed.

Although the prior art mentioned in paragraph 12 of the Office Action may disclose infrared dyes comprising perfluorinated counter-ion, the technical field of this art is so different than that of McCullough that one skilled in the art would not consult these documents, let alone combine them with McCullough, in an effort to address the problems solved by the present invention.

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Vermeersch '444 and Vermeersch '341 each teach a printing plate, with Nakamura being used in the Office Action to teach an infrared absorbing dye as claimed. As mentioned above (Nakamura), these references, even when combined, do not disclose or teach the use of the dyes as claimed.

For the foregoing reasons, withdrawal of the obviousness rejections is respectfully requested.

Conclusion

The application is considered to be in proper condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Christopher T. Griffith, Reg. No. 33,392
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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